

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARTHOLOMEW J. FRAZZITTA,
RANDOLPH C. BENORE, DANIEL S. McINTYRE,
MARK A. DePIETRO, and JEFFREY M. KALMAN

Appeal 2007-0699
Application 08/889,033¹
Technology Center 2600

Decided: 15 February 2008

Before LEE E. BARRETT, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of our decision entered
September 21, 2007, in which we affirmed-in-part the Examiner's rejections
and entered new grounds of rejection.

The request for rehearing has been considered but is denied with
respect to making any modifications in our decision.

¹ Application for patent filed July 7, 1997, entitled "Transaction
System," which is based on and claims priority under 35 U.S.C. § 119(e)(1)
from U.S. Provisional Application 60/045,794, filed May 7, 1997.

DISCUSSION

Appellants allege three errors (Req. Reh'g 2):

Issue 1: Ramachandran (US 5,483,047) does not teach or suggest an ATM supported by a wall.

Issue 2: Ramachandran does not teach or suggest that the fascia (18) has a storage location for a supply of envelopes.

[Appellants' statement of the issue does not correspond to the argument. Appellants do not contest that Ramachandran has a storage location, but argue that our opinion relied upon a different portion of Ramachandran than the Examiner and therefore constitutes a new ground of rejection.]

Issue 3: The new grounds of rejection of claims 15-16 and 45-47 pursuant to 37 C.F.R. § 41.50(b) are legally improper.

Issue 1

Appellants note that each of claims 4, 20, 28, 41, and 45 relate to a customer station frame being in supporting connection with a wall. It is argued that we erred in finding that Ramachandran teaches or suggests an ATM frame supported by a wall (Req. Reh'g 2-4). It is argued that "[o]ne having ordinary skill in the ATM art would recognize that in a through-the-wall arrangement the ATM is supported by a floor (behind the wall)" (Req. Reh'g 4), not by the wall. It is argued that a wall also provides security for the rear area of the ATM, at which bank employees can service the ATM unseen (*id.*). Appellants argue that our decision must be based on personal knowledge of the ATM for us to suggest that it is so "immediately

evident" to have an ATM supported by a wall that it is "not necessary for Ramachandran to disclose details thereof" and Appellants request an affidavit of personal knowledge (Req. Reh'g 4-5).

Initially, we note that the claims only require that the frame in the wall supports one component from the list of a visual display, a customer camera, an audio transmitting device (microphone), an audio receiving device (speaker), and a carrier delivery and receiving device—they do not recite supporting an ATM. We noted that "McClure discloses that the components are mounted to some structure in the wall, but does not disclose the specifics of the structure" (Op. 15). The structures corresponding to frames for supporting components in McClure (e.g. Figs. 2 and 3) appear to be mounted to the back of the wall and not "in the opening" as claimed.

Ramachandran discloses:

There are a number of different types of automated teller machines (ATMs). Some automated teller machines are designed to be inside the wall of a bank and have their customer interface extending through the wall of the bank. This enables customers to conduct their transactions without entering the bank either in a walk-up or drive-up fashion. This type of configuration is known as a "through-the-wall" configuration.

Other ATM units are designed to be freestanding either in the lobby of a bank or other commercial establishment. In these cases the entire ATM is placed on the floor and made operable by appropriate cabling. The lobby type ATMs have the advantage that they are much easier to install than a through-the-wall type machine.

Column 1, lines 24-37. In our opinion, Ramachandran reasonably suggests to one of ordinary skill in the art that a "through-the-wall" type machine is supported by a wall of a bank because it is "designed to be inside the wall of a bank" as opposed to being "freestanding" as in a "lobby type" ATM. That is, Ramachandran suggests that the assembly 40 which houses the ATM components is supported by the wall even if it turns out that the method of support is actually different. Moreover, we think that an ordinary person viewing the ATM fascia 50 in Figures 4 and 7 mounted on the exterior wall of a bank would have been lead to believe that the machine is supported by a wall of the bank. We noted that "the wall and mounting are not expressly illustrated" (Op. 23) in Ramachandran, so we are relying on what the reference teaches or suggests to one of ordinary skill in the art. "[A] reference must be considered not only for what it expressly teaches, but also for what it fairly suggests." *In re Burckel*, 592 F.2d 1175, 1179 (CCPA 1979). Our position is that Ramachandran reasonably suggests to one skilled in the ATM art that "[t]he assembly 40 in Ramachandran is a frame" (Op. 15) and that "[t]he assembly 40 has to be supported somehow by the wall" (Op. 19). The rejection is based on obviousness.

Appellants' argument that "through-the-wall" type machines are actually supported by a floor behind the wall, i.e., that they are freestanding with only their customer interface extending through (but not touching or supported by) the wall, is inconsistent with the statement in Ramachandran that they are "designed to be inside the wall of a bank." We find it unlikely

that a hole in a wall for accepting an ATM would not have a frame as a matter of structural integrity and that an ATM component extending "through the wall" would be designed so it is not supported at all by the frame. Although Appellants, who apparently work for the assignee Diebold, one of the world's leading suppliers of ATMs, are certainly in a position to know how "through-the-wall" ATMs are mounted, they cite no evidence. We find that Ramachandran at least reasonably suggests supporting the ATM assembly on a wall of a bank. Appellants have not cited any Diebold prior art publications at all in this application, so we assume that they were not aware of any Diebold publications that relate to the claimed subject matter of a pneumatic customer receiving and delivery system.

For the reasons above, we find no error in this portion of our opinion.

Issue 2

Appellants argue that we made a new ground of rejection as to claim 11 when we found that Ramachandran described a storage location because the Examiner's rejection relied on element 28 which is a cash delivery door (Req. Reh'g 5). Appellants argue that our affirmance of the rejection of claim 11 is "legally improper" (Req. Reh'g 6).

We disagree that our finding constitutes a new ground of rejection. Appellants had notice of the reference being applied and they are responsible for reading and understanding the entire reference, not just the specific portion noted by the Examiner. The sentence in Ramachandran describing the fascia as having openings for depository envelopes immediately follows

the sentence mentioning element 28, so one of ordinary skill in the art reading the reference would immediately understand that Ramachandran has a storage location as recited in claim 11. Since Ramachandran is assigned to InterBold, which is a joint venture between Diebold and IBM, it might even be expected that Appellants were aware of its teachings. In any case, Appellants had the opportunity to respond to the reasoning in this request for rehearing where they argued the merits of other rejections. We decline to denominate the rejection a new ground of rejection.

Issue 3

Appellants argue that as to the new grounds of rejection of claims 15, 16, and 45-47, that "the teaching McClure is not compatible with the teaching of Gallacher or Ramachandran" (Req. Reh'g 7). It is argued that McClure is a drive-through banking arrangement, not an automated ATM, and McClure does not teach or need the features of an ATM. Thus, it is argued that one skilled in the art would not have considered modifying McClure with ATM features and the rejections are at best hindsight reconstructions (Req. Reh'g 8). Appellants also argue that the new ground of rejection of claims 45 and 46 should be withdrawn because of lack of evidence of an ATM-supporting wall as discussed in Issue 1 (Req. Reh'g 8).

McClure, Gallacher, and Ramachandran are all directed to banking systems. The hypothetical person of ordinary skill in the art is presumed to be familiar with all references within the field of endeavor and to have the skill necessary to apply teachings from one reference to another. McClure

Appeal 2007-0699
Application 08/889,033

has a video camera and display and Gallacher is applied for the video features of a banking system of claims 15 and 16, not for its ATM features. Similarly, Ramachandran is applied for its teaching of mounting components for a banking system in the wall, not for its ATM features. Furthermore, since ATMs came out after McClure, it would have been obvious to add ATM features to the drive-through banking station in McClure. As discussed in connection with Issue 1, we find that Ramachandran reasonably suggests a wall-supported ATM. We are not persuaded of any error in our obviousness conclusions in the new grounds of rejection.

CONCLUSION

The Request for Rehearing of our decision has been considered, but is denied with respect to making any modifications therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

DENIED

Appeal 2007-0699
Application 08/889,033

RALPH E. JOCKE
Walker & Jocke LPA
231 SOUTH BROADWAY
MEDINA, OH 44256